

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the amendments and in view of the reasons that follow. Claims 1, 11, and 20 have been amended. Claims 1-30 are pending in this application.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-10, 11, 13-20 and 22-30

In Section 4.1 of the Office Action, claims 1, 3-10, 11, 13-20 and 22-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0042020 (Schachne) and further in view of U.S. Patent 6,167,383 (Henson). Applicant reserves the right to swear behind both Schachne and Henson. Applicant further respectfully traverses the rejection. Neither Schachne nor Henson alone or in combination disclose, teach, or suggest the claimed invention as recited in claims 1-30.

Claims 2-10 depend from claim 1. Claims 12-19 and 30 depend from claim 11. Claims 21-29 depend from claim 20. Claims 1, 11, and 20 recite:

receiving a request indicating a primary product or service utilizing a network;

displaying the primary product or service on a graphical user interface utilizing the network in response to the request;

display[ing] at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service, the at least one secondary product or service being displayed with the primary product or service in response to the request;

With respect to claims 1, 11, and 20, the Examiner states that “Schachne does not explicitly disclose displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the

primary product or service.” (Office Action dated January 18, 2005, page 4). The Examiner points to Henson as providing this teaching. Specifically, the Examiner states:

Henson in the same field of endeavor teaches displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service.

(Office Action dated January 18, 2005, page 5).

Applicant respectfully disagrees. Henson discloses an “online store [that] enables a custom configuration of a computer system.” (see Abstract). This teaching is clear from the following quotations taken from Henson. “[A] customer of the online store 10 can **build a customer configured machine** by selecting from options listed on the configuration screen 70. Upon obtaining a desired configuration, a customer could then select the ‘ADD TO CART’ icon 74 to add the configured system to the shopping cart” (see col. 6, lines 19-30, Emphasis added). “Validation (or compatibility) provides the customer with a validation message indicating an occurrence of when the options selected for a particular system are not correct.” (see col. 7, lines 58-61). “Validation preferably includes a cross-checking of a combination of options. The cross-checking determines whether or not the particular **combination of options can be physically built.**” (see col. 8, lines 34-37, Emphasis added). Thus, the “options” taught in Henson are not secondary products, but are components of the configured system that should be validated to insure that the customer has selected compatible options so that the product can be physically built.

Henson further distinguishes components of the configured system from secondary products through inclusion of a merchandising message posted to the customer after completing configuration of the computer system. The computer system is configured before it is added to the cart. (see FIG. 3B). Henson discloses that

[s]pace for the display of customer-specific merchandising messaging 100 as to up-sell and cross-sell opportunities are made available in the shopping cart. The entry of a text message in the

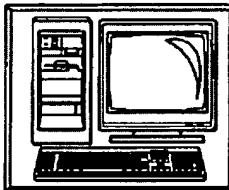
store database 24 triggers the presentation of the merchandising or informational content on the shopping cart web page 102 as shown in FIG. 6.

(see col. 9, lines 41-44, Emphasis added).

Henson further states that “add-ons to the computer system, extended warranty service, software, hardware, printers or other devices, may be **advertised.**” (see col. 10, lines 11-13, Emphasis added). A portion of the FIG. 6 from Henson is reproduced below. This portion includes the merchandising messaging 100 that allows the customer to visit an online catalog to purchase secondary products for the configured computer system. To do so, the customer selects the icon “Software & Add-Ons” and is presented with a catalog screen not described in Henson. Thus, as shown in FIG. 6, Henson does not disclose, suggest, or teach “displaying at least one

102

Fig. 6

| | | | | |
|---|--|--|--|--------------------|
|  DELL.COM HOME | | The Online Store POINT, CLICK, CONFIGURE, BUY. IT DOESN'T GET ANY EASIER. | | |
|  | | Your Shopping Cart Need something to complete your system? Visit our online Software & Add-Ons catalog to shop Dell's single-source solution for software, peripherals, and networking products from the industry's top manufacturers. <input type="radio"/> Business <input checked="" type="radio"/> Personal | | |
| <input type="radio"/> Software & Add-Ons | | 100 | Cart Total: * \$2,406 \$90/month <u>36-Month Lease**</u> | |
| <input type="radio"/> EDIT <input type="radio"/> DELETE | | 104 Description | Qty. | Unit Price* |
| | | Dell Dimension XPS R MiniTower Pentium II processor, 400MHz with 512KB L2 Cache | 1 | \$2,406 |
| | | | UPDATE | Item Total |

secondary product or service associated with the primary product or service ..., the at least one secondary product or service being displayed with the primary product or service in response to the request." Instead, the secondary products are displayed after configuring the primary product and after selecting another icon.

As Examiner acknowledges, Schachne also fails to disclose, suggest, or teach "displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service, the at least one secondary product or service displayed with the primary product or service in response to the request." Schachne discloses that:

A software program ... determines the intention of the customer to **conclude** the business transaction (step 80). Upon this determination and if the customer has provided sufficient information to conduct the business transaction, **an offer is presented to the customer to enter a second business transaction different from the previous business transaction (step 84).**

(see page 2, paragraphs [0021], Emphasis added).

Additionally, according to Schachne, "FIG. 4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48." (see page 3, paragraph [0024]). Thus, the offer is provided after the order form and not with the "primary product or service." Schachne further discloses "when the customer accepts the offer, this concludes the second business transaction **without requiring the customer to submit additional customer information.**" (see page 3, paragraph [0025], Emphasis added). Schachne still further discloses "[b]ecause this process requires no further action from the customer to complete the proposed second business transaction, the relative ease of conducting business transaction may entice the customer to accept the offer." (see page 3, paragraph [0026]).

Schachne teaches away from "displaying at least one secondary product or service associated with the primary product or service utilizing the network **prior to providing a**

purchase order for the primary product or service, the at least one secondary product or service being displayed with the primary product or service in response to the request” as required by claims 1, 11, and 20. According to Schachne, the second offer is made **after** a purchase order and sufficient information has been provided by the customer and **after** the primary product or service is displayed to and selected by the customer for purchase.

For at least the reasons outlined above, Schachne and Henson fail to combine to disclose, suggest, or teach “displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service, the at least one secondary product or service being displayed with the primary product or service in response to the request.” As a result, Schachne and Henson fail to disclose, suggest, or teach all of the limitations of claims 1, 11, and 20. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Claims 2-10, 12-19, and 21-30 depend from one of claims 1, 11, and 20. As a result, Applicant respectfully requests withdrawal of the rejection of claims 1-30.

Claims 2, 12 and 21

In Section 4.2 of the Office Action, claims 2, 12 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachne in view of Henson and further in view of U.S. Patent 6,167,382 (Sparks). Applicant reserves the right to swear behind Sparks. Applicant submits that claims 2, 12, and 21 are allowable for at least the reasons outlined above relative to claims 1, 11, and 20.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2350. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fees to Deposit Account No. 50-2350.

Respectfully submitted,

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By 

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